UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,710	01/13/2006	Tatsuo Sudoh	0033-1052PUS1	1548

2292   7590   03/12/2009
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EXAMINER
STORK, KYLE R

ART UNIT	PAPER NUMBER
2178	

NOTIFICATION DATE	DELIVERY MODE
03/12/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _03 April 2006_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,3-18,20-35,37 and 38_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1,3-18,20-35,37 and 38_ is/are rejected.
7)☒ Claim(s) _1_ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _1.13.06_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This non-final office action is in response to the application filed 13 January 2006

and the preliminary amendment filed 3 April 2006.

2.   Claims 1, 3-18, 20-35, and 37-38 are pending. Claims 1, 18, and 35 are

independent claims.

Information Disclosure Statement

3.   The information disclosure statement (IDS) submitted on 13 January 2006 is in

compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure

statement is being considered by the examiner.

Drawings

4.   The drawings filed 13 January 2006 are accepted by the examiner.

Claim Objections

5.   Claim 1 objected to because of the following informalities: The applicant

indicates in the Remarks filed in conjunction with the preliminary amendment that the

claims "have been amended to remove reference numerals (page 15)." However, claim

1 contains the phrase, "said multimedia data being included in the information selected

by said first information selection unit (102) (see lines 4-5)." Appropriate correction is

required.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

7.   Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

        As per independent claim 1, the applicant discloses an "information output device

(line 1)." However, the applicant discloses a plurality of software units comprising the

information output device. As such, the claimed information output device constitutes a

software system, lacking hardware components. Therefore, the claim is directed toward

software, and fails to fall within one of the statutory categories protected by 35 USC

101, as the claim is not directed toward a process, machine, manufacture, or

composition of matter. For this reason, claim 1 is rejected.

        Dependent claims 2-7 fail to cure the deficiencies of claim 1. Therefore, claims

2-7 are similarly rejected.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

10.   Claims 1, 3-11, 13-14, 17-18, 20-28, 30-31, 34-35, and 37-38 are rejected under

35 U.S.C. 103(a) as being unpatentable over Yamamoto (US 2004/0008373, filed 8 July

2003), and further in view of Watanabe (US 2003/0202585, filed 30 November 1999).

As per independent claim 1, Yamamoto discloses an information output device

comprising:

a first information selection unit selecting information (Figure 5, item S204: Here, the

first information selection unit selects an image for attachment)

an outline presenting information creation unit creating outline presenting

information corresponding to each of a plurality of multimedia data in parallel, said

multimedia data being included in the information selected by said first information

selection unit (paragraph 0011: Here, image forming means for forming an image of the

attachment present the multimedia images simultaneously, in parallel)

a presentation unit presenting said created outline presenting information

(paragraph 0011: Here, the image forming means display the image attachment during

display of the image)

Yamamoto fails to specifically disclose wherein said presentation unit presents alternative information before completion of said outline presenting information creation process, said alternative information including at least intermediate information under course of creation in said outline presenting information creation unit in stages according to respective said outline presenting information creation process and another set of information.

However, Watanabe discloses wherein said presentation unit presents alternative information before completion of said outline presenting information creation process, said alternative information including at least intermediate information under course of creation in said outline presenting information creation unit in stages according to respective said outline presenting information creation process and another set of information (paragraph 0101: Here, the intermediate information presenting an outline is the display of the frames in which the image data will be displayed. Upon completion of obtaining the images, the frames are filled with the image data). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Watanabe with Yamamoto, since it would have allowed a user to view an outline of data while obtaining the data of the outline.

As per dependent claim 3, Yamamoto and Watanabe disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Yamamoto discloses the device further comprising:

an outline presenting information creation control unit controlling execution of said outline presenting information creation process in said outline presenting information creation unit (paragraph 0011)

a storage unit storing outline presenting information (paragraph 0011: Here, a copy of the attachment image is stored at a remote device)

when said outline presenting information is stored in the storage unit (paragraph 0011)

said outline presenting information creation control unit performs control such that said outline presenting information creation process is not executed in said outline presenting information creation unit (paragraph 0011)

said presentation unit presents said outline presenting information stored in said storage unit (paragraph 0011).

As per dependent claim 4, Yamamoto and Watanabe disclose the limitations similar to those in claim 3, and the same rejection is incorporated herein. Yamamoto further discloses a second information selection unit selecting information to be subjected to said outline presenting information creation process based on said information selected by said first information selection unit (paragraph 0011: Here, the second information selection unit selects links to attachment images stored at a remote device)

said outline presenting information creation unit creates outline presenting information for multimedia data included in the information selected by said second

information selection unit and stores the same in the storage unit (paragraph 0011: Here, the email presents a list of attachments, which are stored remotely).

As per dependent claim 5, Yamamoto and Watanabe disclose the limitations similar to those in claim 4, and the same rejection is incorporated herein. Yamamoto further discloses wherein said second information selection unit selects information to be subjected to said outline presenting information creation process based on a status of the information output device (paragraph 0010: Here, the status of the capacity of the mail server is determined. If the email, containing the attached images is below the capacity, the email is sent including the attached images. If the email, containing the attached images is above the capacity, the images are removed. In this instance, the second information selection unit selects the location of the attachment at the remote device. An email containing the image location is sent).

As per dependent claim 6, Yamamoto and Watanabe disclose the limitations similar to those in claim 4, and the same rejection is incorporated herein. Yamamoto further discloses wherein said second information selection unit selects information to be subjected to said outline presenting information creation process based on an attribute of said information selected by said first information selection unit (paragraph 0010).

As per dependent claim 7, Yamamoto and Watanabe disclose the limitations similar to those in claim 4, and the same rejection is incorporated herein. Yamamoto further discloses wherein when information including a plurality of multimedia data is included in multiple pieces of information selected by said second information selection

unit, said outline presenting information creation control unit controls execution of said outline presenting information creation process in said outline presenting information creation unit such tat, for all information selected by said second information selection unit, outline presenting information for at least one multimedia data included in said information is created (Figures 6 and 8; paragraphs 0075-0077 and 0079-0082).

As per dependent claim 8, Yamamoto and Watanabe disclose the limitations similar to those in claim 4, and the same rejection is incorporated herein. Yamamoto further discloses wherein when information including a plurality of multimedia data is included in multiple pieces of information selected by said second information selection unit, said outline presenting information creation control unit controls execution of said outline presenting information creation process in said outline presenting information creation unit such that, for one piece of information selected by said second information selection unit, outline presenting information for multimedia data included in information subsequent to said one piece of information is created after outline presenting information for all multimedia data include in said one piece of information has been created (Figure 6 and 8; paragraph 0075-0077 and 0079-0082: Here, all attachment information is removed if the mail server is over its capacity limit, starting with the first attachment).

As per dependent claim 9, Yamamoto and Watanabe disclose the limitations similar to those in claim 3, and the same rejection is incorporated herein. Yamamoto further discloses the output device further comprising:

a delete outline presenting information selection unit selecting outline presenting information to be subjected to deletion from said storage unit (Figure 14)

a deletion unit deleting said selected outline presenting information (Figure 14)

As per dependent claim 10, Yamamoto and Watanabe disclose the limitations similar to those in claim 9, and the same rejection is incorporated herein. Yamamoto further discloses wherein said deleted outline presenting information selection unit selects said outline presenting information to be subjected to deletion based on an attribute of multimedia data (Figure 14; paragraph 0010).

As per dependent claim 11, Yamamoto and Watanabe disclose the limitations similar to those in claim 9, and the same rejection is incorporated herein. Yamamoto further discloses wherein said deleted outline presenting information selection unit selects said outline presenting information to be subjected to deletion based on a data size of said outline presenting information (paragraph 0010: Here, if the attachment outline size, including the images, is greater than the mail server capacity, the attachment outline is removed).

As per dependent claim 13, Yamamoto and Watanabe disclose the limitations similar to those in claim 9, and the same rejection is incorporated herein. Yamamoto further discloses wherein said deleted outline presenting information selection unit selects said outline presenting information to be subjected to deletion based on a presentation status of said outline presenting information in said presentation unit (paragraph 0013: Here, an email containing attachments cannot be displayed because

the attachment images are deleted. In this instance, a request is generated to present the link to an online location of the images).

As per dependent claim 14, Yamamoto and Watanabe disclose the limitations similar to those in claim 9, and the same rejection is incorporated herein. Yamamoto further discloses wherein when said deleted outline presenting information selection unit selects a plurality of said outline presenting information to be subjected to deletion, said deletion unit deletes prescribed outline presenting information among said outline presenting information to be subjected to deletion such that outline presenting information of at least one multimedia data included in one piece of information is left (Figure 21).

As per dependent claim 17, Yamamoto and Watanabe disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Yamamoto further discloses wherein said multimedia data is data including an image (paragraph 0011) and said outline presenting information unit creates said outline presenting information using at least a part of said image (paragraph 0011).

As per claims 18, 20-28, 30-31, and 34, the applicant discloses the limitations substantially similar to those in claims 1, 3-11, 13-14, and 17, respectively. Claims 18, 20-28, 30-31, and 34 are similarly rejected.

As per claims 35 and 37-38, the applicant discloses the limitations substantially similar to those in claims 1 and 3-4, respectively. Claims 35 and 37-38 are similarly rejected.

11.   Claims 12 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Yamamoto and Watanabe and further in view of Aiyama (US 2002/0076245, filed

13 December 2001).

        As per dependent clam 12, Yamamoto and Watanabe disclose the limitations

similar to those in claim 9, and the same rejection is incorporated herein. Yamamoto

fails to specifically disclose determining the cost of processing information for

presenting the outline data. However, Aiyama discloses determining the cost of

processing information for presenting the outline data (paragraph 0075). It would have

been obvious to one of ordinary skill in the art at the time of the applicant's invention to

have combined Aiyama with Yamamoto, since it would have allowed a user to base

deletion determination upon the cost of processing the outline image data.

        As per claim 29, the applicant discloses the limitations substantially similar to

those in claim 12, Claim 29 is similarly rejected.

12.   Claims 15-16 and 32-33 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Yamamoto and Watanabe and further in view of Menich (US

2003/0187632, filed 2 April 2002).

        As per dependent claim 15, Yamamoto and Watanabe disclose the limitations

similar to those in claim 1, and the same rejection is incorporated herein. Yamamoto

fails to specifically disclose controlling a timing of presentation. However, Menich

discloses controlling a timing of a presentation (paragraph 0003). It would have been

obvious to one of ordinary skill in the art at the time of the applicant's invention to have

combined Menich with Yamamoto, since it would have allowed a user to controls timing of outline presentation.

As per dependent claim 16, Yamamoto, Watanabe, and Menich disclose the limitations similar to those in claim 15, and the same rejection is incorporated herein. Menich further discloses wherein outline presenting information is presented after expiration of a time interval (paragraph 0003). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Menich with Yamamoto, since it would have allowed a user to controls timing of outline presentation.

As per claims 32-33, the applicant discloses the limitations similar to those in claims 15-16, respectively. Claims 32-33 are similarly rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYLE R. STORK whose telephone number is (571)272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Stork/

Kyle R Stork
Primary Examiner
Art Unit 2178

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